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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,994	12/06/2004	Yuichi Inada	59559.00015	1323
32294 7590 08/07/2008 SQUIRE, SANDERS & DEMPSEY L.L.P. 8000 TOWERS CRESCENT DRIVE 14TH FLOOR VIENNA, VA 22182-6212				
EXAMINER				
HEITBRINK, JILL LYNNE				
ART UNIT		PAPER NUMBER		
1791				
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08/07/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/516,994

Applicant(s)

INADA ET AL.

Examiner

Jill L. Heitbrink

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 May 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

Specification

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-6 and 9-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

3. The support member extending rearward from "a center portion of a disc-shaped member in the thickness direction" does not have support in the original application since the support member which would be bearing 49 does not extend from the disc-shaped member which would be mirror surface disc 36. There is no contact between the bearing 49 and the mirror surface disc 36 since the tubular bush 47 is positioned there between. Applicant should use terms which have clear support in the original specification.

4. Claim 12 has been amended such that a flow passage is formed near the front end portion of the disc-molding mold. This does not have support in the original specification.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 11-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. Claims 11 and 12 are directed to "A bush" (line 1). However, the bush is only element 47 in the specification. The claims are unclear as to how the other elements in the claim limit the bush. Applicant argues the claims as if the other elements are part of the bush. However, the other elements are part of the disc-molding mold.
8. Claim 12, line 3 is unclear as to the element that "thereof" is referring. The claimed is being examined with a passage being formed near the front end portion of the disc-molding mold.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-6 and 9-12 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Japanese Publication 2003-165146. Cylinder 27 (bush) surrounds the

machining member (gate cut sleeve 29) and has a flow passage (28) in a front end portion. Fig. 1 shows the radial dimension of the flow passage of the sprue bush being greater than an inner diameter of a supply passage for supplying temperature control medium to the flow passage of the sprue bush. A support member (32) extends rearward from a position near the flow passage formed in the front end portion of the bush and the supply passage (28D) for supplying the temperature control medium to the flow passage of the bush is formed along the support member bearing 32 as shown in Fig. 3. Additionally, the front end portion of the machining member does not have any defined length or size or relative dimension to other elements in the claims. The support member 32 extending rearward from a center portion of a disc-shaped member in the thickness direction is shown in JP'146 wherein the disc-shaped member is the equivalent to the combined retainer plate 22 and backing plate 21 which combined are disc-shaped. The examiner notes that applicant's disclosed interior plate 40 and mirror-shaped disc 36 are bolted together and thus the defining of the center portion of the disc-shaped member may include either or both plates 36 and 40.

11. Additionally, the claims are written in such broad language that another characterization of JP '146 is equivalent to the claims. In this second correspondence, the ejector pin 30 is equivalent to the machining member, the cylinder 27 is equivalent to the bush, and the gate cut sleeve 29 is equivalent to the support member disposed between the machining member 30 and the bush 27 wherein the support member 29 extends rearward from a center portion of a disc-shaped member 22 in the thickness direction.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 1-6 and 9-12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Publication 2003-165146. The providing a lubricant for the bearings 32 would have been obvious to a person of ordinary skill in the art of bearings and moving members. The discharge passage would clearly be the open space below the bearing. The positioning of the bearing such as to extend rearward from a center portion of a disc-shaped member (if equivalent to the core block 24) in the thickness direction would have been obvious to a person of ordinary skill in the art depending upon the thickness of the core block which may be enlarged in relationship to the backing plate since this would not effect the movement of the machining member. The examiner notes that applicant's disclosed interior plate 40 and mirror-shaped disc 36 are bolted together and thus the defining of the center portion of the disc-shaped member may include either or both plates 36 and 40. The process of operating the support member would have been obviously similar to the operation of the bearing in JP'146 since the position near the support member to the center of the disc-shaped member would operate in a similar manner. The product produced by JP'146 would have obviously been similar to that claimed since the bearing does not contact the molded product.

Response to Arguments

14. Applicant's arguments filed May 9, 2008 have been fully considered but they are not persuasive.

15. Applicant's amendment to claims 11-12 which are directed to "A bush" have not been overcome since the arguments are clearly directed to limitations which are not part of "a bush". As stated in MPEP 2171: "The inquiry during examination is patentability of the invention as applicant regards it. If the claims do not particularly point out and distinctly claim that which applicants regard as their invention, the appropriate action by the examiner is to reject the claims under 35 U.S.C. 112, second paragraph. In re Zletz, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989). If a rejection is based on 35 U.S.C. 112, second paragraph, the examiner should further explain whether the rejection is based on indefiniteness or on the failure to claim what applicants regard as their invention. Ex parte Ionescu, 222 USPQ 537, 539 (Bd. App. 1984)." Applicant should amend the claims such as to be directed to the limitation which are included in the structure.

16. As stated in MPEP 2111,

>II. IT IS IMPROPER TO IMPORT CLAIM LIMITATIONS FROM THE SPECIFICATION "Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment." Superguide Corp. v. DirecTV Enterprises, Inc., 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004). See also Liebel-Flarsheim Co. v. Medrad Inc., 358 F.3d 898, 906, 69 USPQ2d 1801, 1807 (Fed. Cir. 2004)(discussing recent cases wherein the court expressly rejected the contention that

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if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment);<

17. Applicant's arguments are directed to the operation of parts with functions which are not claimed. Applicant is not claiming preventing eccentricity, a punch hole punching or a disc substrate. Applicant is not claiming a bush, a cut punch, a mirror surface disc, any tightening, inclination of the cut punch, or a common axis.

18. Applicant argues that a person of ordinary skill in the art would have understood that generation of inclination of the core block 24 cannot be prevented because of the cylinder's 27 instability in Toshihiro '146. However, this is not claimed by applicant. Additionally, no instability is disclosed or taught by Toshihiro '146. Paragraph [0016] clearly states that the barrel 27 is fixed to the inner circumference section of the core block 24 as is shown in the Figures.

19. Applicant states that "the cylinder 27 and the core block 24 fail to share a common axis" in Toshihiro '146. The examiner can not find any evidence of this in Toshihiro. Applicant should indicate where this is disclosed in Toshihiro. Additionally, applicant does not disclose a common axis in the specification.

Allowable Subject Matter

20. Claim 7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. Applicant's arguments, see

amendment page 14, filed April 9, 2007, with respect to JP'146 have been fully considered and are persuasive.

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill L. Heitbrink whose telephone number is (571) 272-1199. The examiner can normally be reached on Monday-Friday 9 am -2 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jill L. Heitbrink/
Primary Examiner, Art Unit 1791

Jill L. Heitbrink
Primary Examiner
Art Unit 1791

jlh